Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PHILIP R. THRIFT
and
CHARLES T. HEMPHILL

Appeal No. 1998-1109
Application No. 08/419,229

ON BRIEF

Before JERRY SMITH, FLEMING, and RUGGIERO, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

REMAND TO THE EXAMINER

On August 9, 2002, the United States Court of Appeals for the Federal Circuit issued a decision on an appeal taken from the decision of the Board of Patent Appeals and Interferences affirming the Examiner's rejection of claims 1-19 for obviousness under 35 U.S.C. § 103. In this decision on appeal, the court affirmed the Board's decision as to claims 1-10, but vacated and remanded for further consideration the Board's decision affirming

the Examiner's rejection of claims 11-19. See In re Thrift, 298 F.3d 1357, 63 USPQ2d 2002 (Fed. Cir. 2002). The above-identified application is hereby remanded to the Examiner for appropriate action consistent with the decision of the CAFC and our comments below.

Should the Examiner, after further consideration, decide that it is appropriate to reopen prosecution, we make the following observations.

As stated in the CAFC decision of August 9, 2002, the court noted that independent claims 11 and 14 differ from independent claim 1, the obviousness rejection of which was upheld by the court, by adding a grammar creation capability to the claimed voice activated Hypermedia system. The court's decision concluded that the Board erred in affirming the obviousness rejection of independent claims 11 and 14 since the Examiner's assertion that " . . . [t]he use of grammar is old and well known in the art of speech recognition . . . " was unsupported by any evidence. Accordingly, in any future formulation of an obviousness rejection of independent claims 11 and 14, the Examiner is required, as a starting point, to provide clear evidence of the existence in the prior art of grammar creation capability in speech recognition systems. In addition, the

Examiner must address the particular limitations of independent claim 11 which requires the extracting, modifying, and processing of grammar as part of interaction with a hypermedia source, and independent claim 14 which sets forth a requirement of grammar production from textual representation of information resource links.[1]

Further, as part of the review of this application, the Examiner should recognize that the language of claims 11-19 is presented in "means-plus-function" format. When claimed elements are defined by "means-plus-function" format, they are interpreted as being limited to the corresponding structure described in the specification or the equivalents thereof consistent with 35 U.S.C. § 112, paragraph 6. In re Donaldson Co., 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848 (Fed. Cir. 1994)(en banc); See also Manual of Patent Examining Procedure (MPEP) § 2181 (8th Ed., August 2001) for the guideline for invoking 35 U.S.C. § 112, sixth paragraph. The Examiner must therefore determine the precise scope of the appealed claims consistent with 35 U.S.C.

[1] In particular, with regard to the limitations of independent claim 14, the Examiner should review the Schmandt reference and the discussion of the "Xspeak II" enhancement beginning at page 54 which appears to suggest the production of grammar to aid in the interaction with particular applications.

§ 112, sixth paragraph, and must consider how the art of record, as well as any newly discovered prior art, may be applicable to the determination of the patentability of properly construed claims 11-19.

APPROPRIATE ACTION

We remand this application to the Examiner for action consistent with the above.

This application, by virtue of its "special" status requires immediate action. See (MPEP) 708.01 (8th Ed., Aug. 2001). It is important that the Board be informed promptly of any action affecting the appeal in this application.

REMANDED

JERRY SMITH)
Administrative Patent Judge)
)
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MICHAEL R. FLEMING) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
) INTERFERENCES
)
JOSEPH F. RUGGIERO)
Administrative Patent Judge)

JFR:hh

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